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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/944,233	08/30/2001	Walter L. Moden	3161.3US (97-0116.2)	2436
24247	75901	12/31/2003	EXAMINER	
TRASK BRITT			LAMB, BRENDA A	
P.O. BOX 2550			ART UNIT	
SALT LAKE CITY, UT 84110			PAPER NUMBER	
			1734	

DATE MAILED: 12/31/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/944233

Applicant(s)

Moden et al

Examiner

LAMB

Group Art Unit

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— The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address —

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- ☒ Responsive to communication(s) filed on Paper #16 filed 9/3/03 and
Paper #17 filed 9/3/03
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-51 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-51 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement

Application Papers

- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☐ All ☐ Some* ☐ None of the:
- ☐ Certified copies of the priority documents have been received.
- ☐ Certified copies of the priority documents have been received in Application No. _____.
- ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received: _____

Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 17
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

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The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-51 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-78 of copending Application No. 10/361,240. Although the conflicting claims are not identical, they are not patentably distinct from each other because copending application claims as apparatus for applying adhesive to one or more underside surfaces for at least once semiconductor component which is comprised of an adhesive reservoir configured to provide an exposed surface of the adhesive material contained therein to each of one or more underside surfaces of at least one semiconductor component positioned thereover, the adhesive reservoir comprising at least one pool chamber defined by at least one upward facing opening, the adhesive reservoir shaped such that the exposed surface of the adhesive reservoir may be supplied to a precise location above the at least one upward facing opening, the adhesive material having a surface tension and at least one mechanisms as in claim 1 or second mechanism in claim 26 associated with the adhesive reservoir to level the exposed surface of the adhesive reservoir to a

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precise location above the upward facing opening, to maintain the exposed surface at a substantially constant height and manipulate the difference in pressure within the adhesive material and ambient air to be equal to twice the surface tension of the adhesive. The copending application claims mechanism for controlling extrusion to a selectable height is a pump and control system. With respect to claims 6-20 and 31-46, the copending application claims a coating stencil positioned over the upwardly facing opening of the reservoir, the stencil opening having shape, size and frequency within the scope of the claims. With respect to claims 21 and 47, the copending application claims vacuum applied on the bottom side of the stencil. The copending application claims a mechanism for bringing the semiconductor component in contact with the exposed surface of the adhesive material as set forth in claims 22 and 48. The copending application claims a recirculation system as set forth in claims 23 and 49. The copending application claims the mechanisms for leveling the exposed surface of the adhesive material. The copending application claims the semiconductor component is comprised of at least one lead finger of a lead frame as set forth in claims 25 and 51. The copending application claims the upwardly facing opening with the adhesive material is configured to provide a meniscus through stencil opening as set forth in claims 2 and 27. The copending application claims the recited mechanism is configured to manipulate the surface tension of the adhesive to flatten the exposed surface of adhesive and use surface tension to control surface area and thickness of adhesive available for application as set forth in claims 3 and 28.

Claims 1-3, 6-20, 24-28, 31-46 and 50-51 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-22 of U.S. Patent No. 6,336,973 (Moden et al). Although the conflicting claims are not identical, they are not patentably distinct from each other because Moden et al claims an apparatus for applying adhesive to one or more underside surfaces for at least once semiconductor component which is comprised of an adhesive reservoir configured to provide an exposed surfaces of at least one semiconductor component positioned there over, the adhesive reservoir comprising at least one pool chamber defined by at least one upward facing opening, the adhesive reservoir shaped such that the exposed surface of the adhesive reservoir may be supplied to a precise location above the at least one upward facing opening, the adhesive material having a surface tension and at least one mechanisms as in claim 1 or second mechanism in claim 26 associated with the adhesive reservoir to level the exposed surface of the adhesive reservoir to a precise location above the upward facing opening, to maintain the exposed surface at a substantially constant height and manipulate the difference in pressure within the adhesive material and ambient air to be equal to twice the surface tension of the adhesive. The Moden et al claims mechanism for controlling extrusion to a selectable height is a pump and control system. With respect to claims 6-20 and 31-46, Moden et al claims a coating stencil positioned over the upwardly facing opening of the reservoir, the stencil opening having shape, size and frequency within the scope of the claims. With respect to claims 25 and 51, the copending application claims the semiconductor component is comprised of at least one lead finger. With respect to claim

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24 and 50, it would have been obvious to attach the Moden et al stencil in the Moden et al apparatus for the obvious reason to increase the stability of the apparatus. With respect to claims 3 and 28, Moden et al claims controlling extrusion of adhesive material through the stencil to a levelness or flattened level above the top surface of the stencil which is the exposed surface of the adhesive material. With respect to claims 2 and 27, the adhesive material is capable of forming a meniscus.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1-51 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The originally filed specification fails to teach at least one mechanism which includes a pump and control system which can be narrowly read to be limited to a pump and control system which is configured to level the exposed surface of adhesive material at a precise location above the at least one upward facing opening and maintain the exposed surface of adhesive material at a substantially constant height.

The originally filed specification fails to teach a mechanism manipulates the difference in pressure within the adhesive material and ambient air to be equal to twice the surface tension of the adhesive material divided by the radius of curvature of the adhesive material. Note the omission that the radius of curvature of the adhesive

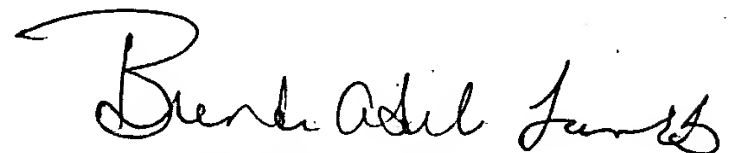
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material is determined as the adhesive material is extruded through the stencil opening presents new matter since it infers that the radius of curvature is determine in other ways that are not disclosed by the originally filed specification.

Any inquiry concerning this communication should be directed to Brenda Lamb at telephone number (571) 272-1231. The examiner can normally be reached on Monday through Tuesday and Thursday through Friday with alternate Wednesdays off.

B. Lamb/lap

December 3, 2003


BRENDA A. LAMB
PRIMARY EXAMINER